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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,636	12/06/2001	Jurina Wessels	450117-03592	1870
20999	7590	02/25/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			BAKER, MAURIE GARCIA	
			ART UNIT	PAPER NUMBER
			1639	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8.14

**Office Action Summary**

**Application No.**

10/006,636

**Applicant(s)**

WESSELS ET AL.

**Examiner**

Maurie G. Baker

**Art Unit**

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 13-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                               |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/06/01</u> . | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. Applicant's Response filed December 8, 2003 is acknowledged. No claims were amended, added or cancelled in this response. Therefore, claims 1-17 are pending.

#### *Election/Restriction*

2. Applicant's election of Group II (claim 12) with traverse is acknowledged. The traversal is addressed below.

3. Applicants argue that searching all of the inventions would not create an undue burden to the Office, stating that the "present claims clearly represent a web of knowledge and continuity of effort that merits examination in a single application" (Response, page 3). The examiner respectfully disagrees. As stated in the Restriction Requirement, the groups that describe each of the separate inventions each have different issues regarding patentability and enablement, and represent patentably distinct subject matter, which merits separate and burdensome searches.

4. To summarize from the previous action, Groups I – IV represent separate and distinct products where the products have different structures. They differ in respect to their properties, their use and the synthetic methodology for making them. Groups IV and V are related as product and process of use. In the instant case, the process for using the product as claimed can be practiced with another materially different product. That is, a use as "self-assembled electronic circuit elements, electrodes and metal coatings" could be carried out with a wide variety of assemblies of different structure (i.e. different from those set forth in the instant

claims). Lastly, Groups I – III are not related to Group V. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, method of use of Group V utilizes a 1-, 2-, or 3-dimensional assembly of nanostructured units, not a multifunctional linker molecule, per se.

5. Furthermore, art anticipating or rendering obvious each of the groups respectively would not necessarily anticipate or render obvious another group, because they are drawn to different inventions that have different distinguishing features and/or characteristics. Each group could support a separate patent. The different inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. The different inventions would require different searches in the patent and non-patent databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper and is made FINAL.

6. Therefore, claims 1-11 and 13-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions. Claim 12 is under examination in this action.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Aoyama et al (JP 51042174).

Aoyama et al discloses a compound that reads directly on the claimed compound 1,4-dithiocarbamatobenzene. See column 1, bottom on page marked 73. Especially note the English abstract printed from the STN database CAPLUS that is attached to the patent. The abstract recites p-phenylenebis(dithiocarbamate) having STN Registry No. [46350-14-5]. A printout of the entry for STN Registry No. [46350-14-5] is also included. This compound is the same as the claimed 1,4-dithiocarbamatobenzene.

### *Conclusion*

9. No claims are allowed.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (571) 272-0805. The examiner is on an increased flextime schedule; the best time to contact the examiner is Monday-Friday from 6:00-10:00 a.m.
11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of

a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Maurie Garcia Baker, Ph.D.  
February 20, 2004

A handwritten signature in black ink, appearing to be 'MB' with a long horizontal stroke extending to the right.

**MAURIE GARCIA BAKER PH.D.**  
**PRIMARY EXAMINER**